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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,782	02/28/2005	Michael Neumann	026032-4855	8507
22428 7590 06/12/2008 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
HAN, JASON				
ART UNIT		PAPER NUMBER		
2875				
MAIL DATE		DELIVERY MODE		
06/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/525,782

Applicant(s)

NEUMANN, MICHAEL

Examiner

JASON M. HAN

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 17, 20-28, 30-32 and 35-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 17, 20-28, 30-32 and 35-47 is/are rejected.
- 7) ☒ Claim(s) 16 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 18, 2008 has been entered.

Response to Arguments

2. Applicant's arguments with respect to Claims 16-21 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

3. Claim 16 is objected to because of the following informalities: "a translucent covering layer wherein" is missing a comma and is suggested to read as "a translucent covering layer, wherein". Appropriate correction is required.

4. Claim 24 is objected to because of the following informalities: The recitation in the last two lines of the claim, "an output of light on the surface side of the optical conductor facing the interior", lacks antecedent basis and is suggested to read as "an output of light on a surface side of the optical conductor facing the interior". Appropriate correction is required.

The following claims have been rejected in light of the specification, but rendered the broadest interpretation as stated by the Applicant within the context of the claim language and as construed by the Examiner [MPEP 2111].

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 16-17, 20-21, and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Misaras (U.S. Patent 6,652,128 B2).

7. With regards to Claim 16, Misaras discloses a lining element for a vehicle [Abstract] including:

- A base part [Figure 1: (108, 110)];
- A surface side facing the interior of the vehicle and suitable for emitting light [Figure 1: (102)];
- At least one mirror surface distributed in the lining element to reflect light therefrom [Figure 1: (108); Column 3, Lines 51-53]; and

- A translucent covering layer [Figure 1: (102, 104)], wherein the covering layer is designed to be elastically compressible,
 - Wherein the translucent covering layer includes an elastomer that has an at least partially foamed structure [Column 2, Line 65 – Column 3, Line 2].
8. With regards to Claim 17, Misaras discloses the base part [Figure 1: (108, 110)] being a light generator [Column 3, Line 30].
9. With regards to Claim 20, Misaras discloses the base part [Figure 1: (108, 110)] including at least one of an electroluminescent film, organic light-emitting diode and poly light-emitting diode [Column 3, Line 34].
10. With regards to Claim 21, Misaras discloses the translucent covering layer including an elastomer that is at least one of ethylene propylene dien monomer, silicone and polyurethane [Column 3, Line 1].
11. With regards to Claim 46, Misaras discloses the at least one mirrored surface being an angled mirrored surface [Figure 1: (108); Column 3, Lines 51-53].
12. Claims 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Misaras (U.S. Patent 6,652,128 B2).
13. With regards to Claim 22, Misaras discloses a lining element for a vehicle [Abstract] including:
- A base part [Figure 1: (106, 108, 110)];
 - A surface side facing the interior of the vehicle and suitable for emitting light [Figure 1: (102)];

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- At least one mirror surface distributed in the lining element to reflect light therefrom [Figure 1: (108); Column 3, Lines 51-53]; and
 - A translucent covering layer [Figure 1: (102, 104)], wherein the covering layer is designed to be elastically compressible,
 - Wherein the translucent covering layer includes an elastomer that is at least one of ethylene propylene diene monomer, silicone and polyurethane [Column 2, Line 65 – Column 3, Line 2];
 - Wherein the elastomer having a hardness of 20 to 70 Shore A [Column 3, Lines 21-23].
14. With regards to Claim 23, Misaras discloses the base part being designed as a plate-like optical conductor [Figure 1: (106, 108)], which is operationally associated with a light generator [Figure 1: (110)].
15. Claims 24-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Misaras (U.S. Patent 6,652,128 B2).
16. With regards to Claim 24, Misaras discloses a lining element for a vehicle [Abstract] including:
- A base part [Figures 1, 3: (314)];
 - A surface side facing the interior of the vehicle and suitable for emitting light [Figures 1, 3: proximate (304A,B,C)];
 - At least one mirror surface distributed in the lining element to reflect light therefrom [Figure 1: (108); Column 3, Lines 51-53]; and

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- A translucent covering layer [Figures 1, 3: (102, 104, 302)], wherein the covering layer is designed to be elastically compressible,
 - Wherein the base part is designed as a plate-like operator, which is operationally associated with a light generator [Figure 1: (110); Column 4, Lines 24-25], and
 - Wherein the optical conductor includes at least one of polymethyl methacrylate and polycarbonate material having a structure allowing an output of light on a surface side of the optical conductor facing the interior [Column 4, Lines 48-56].
17. With regards to Claim 25, Misaras discloses the covering layer including a layer of a gel-like substance [Figure 1: (104)] covered toward the interior of the vehicle by a plastic film [Figures 1, 3: (102, 302)].
18. Claim 44 is rejected under 35 U.S.C. 102(e) as being anticipated by Misaras (U.S. Patent 6,652,128 B2).

Misaras discloses a lining element for a vehicle [Abstract] including:

- A base part [Figures 1, 3: (314)];
- A surface side facing the interior of the vehicle and suitable for emitting light [Figures 1, 3: proximate (304A,B,C)];
- At least one mirror surface distributed in the lining element to reflect light therefrom [Figure 1: (108); Column 3, Lines 51-53]; and
- A covering layer [Figures 1, 3: (102, 104, 302)],

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- Wherein the base part is designed as a generally plate-like operator including at least one of polymethyl methacrylate and polycarbonate material [Column 4, Lines 48-56].

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misaras (U.S. Patent 6,652,128 B2) in view of Miller (U.S. Patent 6,227,689 B1).

21. With regards to Claim 22, Misaras discloses a lining element for a vehicle [Abstract] including:

- A base part [Figure 1: (108, 110)];
- A surface side facing the interior of the vehicle and suitable for emitting light [Figure 1: (102)];
- At least one mirror surface distributed in the lining element to reflect light therefrom [Figure 1: (108); Column 3, Lines 51-53]; and
- A translucent covering layer [Figure 1: (102, 104)], wherein the covering layer is designed to be elastically compressible,
- Wherein the translucent covering layer includes an elastomer that is at least one of ethylene propylene diene monomer, silicone and polyurethane [Column 2, Line 65 – Column 3, Line 2].

Misaras does not specifically teach the elastomer having a hardness of 20 to 70 Shore A.

Miller teaches, "Preferably, body 16 of bulb holder 10 is injection molded with at least two stampings 46. Body 16 may be molded from a flexible polymeric material, preferably having a Shore A durometer hardness of between approximately 50 Shore A and 105 Shore A, more preferably between approximately 60 Shore A and 90 Shore A, and most preferably approximately 60 Shore A, such as a thermoplastic elastomer (TPE) material, such as Kraton G7720B or the like. Alternatively, a plasticized poly vinyl chloride (PVC) material, a flexible urethane, a silicone or the like may be used, without affecting the scope of the present invention. By injection molding of body 16 with the stampings within the flexible material, the present invention assures a water-tight construction to substantially preclude water from entering the terminals 20 and 24 within body 16" [Column 5, Lines 29-44].

It would have been obvious to one ordinarily skilled in the art at the time of invention to modify the lining element of Misaras, specifically the elastomer, to incorporate the Shore durability characteristics, as principally taught by Miller, so as to ensure appropriate hardness and flexibility of the elastomer. It has also been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233].

22. With regards to Claim 23, Misaras in view of Miller discloses the claimed invention as cited above. In addition, Misaras teaches the base part being designed as

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a plate-like optical conductor, which is operationally associated with a light generator [Figure 1: (108, 110)].

23. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misaras (U.S. Patent 6,652,128 B2).

Misaras discloses the claimed invention as cited above, but does not specifically teach the plastic film on the side of the interior having a thickness of 0.1 to 1.5 mm (re: Claim 26); the covering element having an overall thickness of 1.0 to 5.0 mm (re: Claim 27); or the gel-like substance having a dynamic viscosity of 0.01 to 10 Pa·s (re: Claim 28).

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the plastic film on the side of the interior to have a thickness of 0.1 to 1.5 mm; the covering element to have an overall thickness of 1.0 to 5.0 mm; and the gel-like substance to have a dynamic viscosity of 0.01 to 10 Pa·s, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. In this case, one would want the film/covering element to be of a relative thinness, as well as have a specific dynamic viscosity, in order to ensure that the gel-like substance is relatively flexible or deformable.

24. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Misaras (U.S. Patent 6,652,128 B2).

Misaras discloses the claimed invention as cited above, but does not specifically teach the translucent covering layer having an optical transmissivity in the visible spectral range of 1 to 25%.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the translucent covering layer to have an optical transmissivity in the visible spectral range of 1 to 25%, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. In this case, one would want to provide the translucent covering layer with an optical transmissivity for its intended purpose, such as a non-overbearing illumination.

25. Claims 31-32, 35-36, 38-43, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misaras (U.S. Patent 6,652,128 B2).

26. With regards to Claim 31, Misaras discloses a lining element for a vehicle [Abstract] including:

- A base part [Figure 1: (108, 110)];
- A surface side facing the interior of the vehicle and suitable for emitting light [Figure 1: proximate (102)];
- At least one mirror surface distributed in the lining element to reflect light therefrom [Figure 1: (108); Column 3, Lines 51-53]; and
- A covering layer [Figure 1: (102, 104, 106)].

Misaras does not specifically teach the translucent covering layer having an optical transmissivity in the visible spectral range of 5 to 10%.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the translucent covering layer to have an optical transmissivity in the visible spectral range of 5 to 10%, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. In this case, one would want to provide the translucent covering layer with an optical transmissivity for its intended purpose, such as a non-overbearing illumination.

27. With regards to Claim 32, Misaras discloses the claimed invention as cited above, and teaches the covering layer being generally elastically compressible [Column 2, Line 65 – Column 3, Line 2].

28. With regards to Claim 35, Misaras discloses the claimed invention as cited above, and teaches the translucent covering layer including an elastomer including an at least partially foamed structure [Figure 1: (102, 104, 106); Column 2, Line 66].

29. With regards to Claim 36, Misaras discloses the claimed invention as cited above, and teaches the elastomer including at least one of ethylene propylene diene monomer, silicone and polyurethane material [Figure 1: (102, 104, 106); Column 3, Line 1].

30. With regards to Claim 38, Misaras discloses the covering layer including a layer of a gel-like substance [Figure 1: (104)] covered toward the interior of the vehicle by means of a film [Figure 1: (102)].

31. With regards to Claim 39, Misaras discloses the film including a plastic material [Column 2, Line 64 - Column 3, Line 27].

32. With regards to Claim 40, Misaras discloses the claimed invention as cited above, but does not specifically teach the gel-like substance having a dynamic viscosity of 0.01 to 1 Pa·s.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the gel-like substance to have a dynamic viscosity of 0.01 to 1 Pa·s, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. In this case, one would want the gel to have a specific dynamic viscosity as identified above, in order to ensure that the gel-like substance is relatively flexible or deformable while maintaining stiffness/hardness.

33. With regards to Claim 41, Misaras discloses the claimed invention as cited above. In addition, Misaras teaches the gel-like substance [Figure 1: (104)] being arranged between two layers [Figure 1: (102, 106)], whereby one of the layers [Figure 1: (102)] is a plastic film [Column 3, Line 3]. Misaras does not specifically teach the other of the films being plastic.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the films out of plastic, since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. In this case, the availability of plastic is conducive to manufacturability and would be suitable for its stiffness/hardness characteristic.

34. With regards to Claims 42, Misaras discloses the claimed invention as cited above, but does not specifically teach the plastic films having a thickness of approximately 0.5 to 1.0 mm.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the plastic films to have a thickness of approximately 0.5 to 1.0 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. In this case, one would want to ensure the films to be of a relatively thinness, so that they provide an aesthetically pleasing yet durable material.

35. With regards to Claim 43, Misaras discloses the claimed invention as cited above, but does not specifically teach the covering layer having a thickness overall of approximately 2.0mm to approximately 3.0mm.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the covering layer to have a thickness overall of approximately 2.0 to approximately 3.0 mm, since it has been held that where the

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general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. In this case, one would want to ensure that the covering element to be of a relatively thinness, so that it take up too much space yet is still an aesthetically pleasing and durable material.

36. With regards to Claim 45, Misaras discloses the claimed invention as cited above. In addition, Misaras teaches the base part [Figure 1: (108, 110)] including at least one of an electroluminescent film, organic light-emitting diode and poly light-emitting diode [Column 3, Line 34].

37. With regards to Claim 47, Mirasas discloses the claimed invention as cited above, and teaches the at least one mirrored surface being an angled mirrored surface [Figure 1: (108); Column 3, Lines 51-53].

38. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Misaras (U.S. Patent 6,652,128 B2) as applied to Claim 35 above, and further in view of Miller (U.S. Patent 6,227,689 B1).

Misaras discloses the claimed invention as cited above, but does not specifically teach the elastomer having a hardness of APPROXIMATELY (broad interpretation – MPEP 2111) 40 Shore A.

Miller teaches, "Preferably, body 16 of bulb holder 10 is injection molded with at least two stampings 46. Body 16 may be molded from a flexible polymeric material, preferably having a Shore A durometer hardness of between approximately 50 Shore A and 105 Shore A, more preferably between approximately 60 Shore A and 90 Shore A,

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and most preferably approximately 60 Shore A, such as a thermoplastic elastomer (TPE) material, such as Kraton G7720B or the like. Alternatively, a plasticized poly vinyl chloride (PVC) material, a flexible urethane, a silicone or the like may be used, without affecting the scope of the present invention. By injection molding of body 16 with the stampings within the flexible material, the present invention assures a water-tight construction to substantially preclude water from entering the terminals 20 and 24 within body 16" [Column 5, Lines 29-44].

It would have been obvious to one ordinarily skilled in the art at the time of invention to modify the lining element of Misaras, specifically the elastomer, to incorporate the Shore durability characteristics, as principally taught by Miller, so as to ensure appropriate hardness and flexibility of the elastomer. It has also been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON M. HAN whose telephone number is (571)272-2207. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jason M Han
Examiner
Art Unit 2875

JMH
June 4, 2008

/Sandra L. O'Shea/
Supervisory Patent Examiner, Art Unit 2875